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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,191	03/29/2001	Martin A. Kenner	56095US002	4517
32692	7590	03/09/2004	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			YOUNG, JOHN L	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 03/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,191

Applicant(s)

KENNER ET AL.

Examiner

John L. Young

Art Unit

3622

ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

John Leonard Young, Esq.
JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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FIRST ACTION REJECTION

DRAWINGS

1. This application has been filed with drawings that are acceptable for examination and publication purposes. The review process for drawings that are included with applications on filing has been modified in view of the new requirement to publish applications at eighteen months after the filing date of applications, or any priority date claimed under 35 U.S.C. §§119, 120, 121, or 365.

CLAIM REJECTIONS — 35 U.S.C. §101

35 U.S.C. §101 reads as follows:

2. **Rejections Withdrawn.**

CLAIM REJECTIONS — 35 U.S.C. §103(a)

ORIGINAL CLAIM REJECTIONS

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. Claims 1-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morton 6,327,572; class 705/10 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as "Morton").

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As per claim 1, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows: “A method comprising: posting a note at a content provider, wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity.”

Morton lacks an explicit recitation of “wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . .” It would have been obvious to a person of ordinary skill in the art at the time of the invention that the disclosure of Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) would have been selected in accordance with “wherein the content provider is a first party; performing an activity related to the note, wherein the activity is performed by a content recipient, and wherein the content recipient is a second party; and, providing payment to a third part based upon the activity. . . .” because, such selection would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

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As per claims 2-28, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 1 and subsequent base claims depending from claim 1.

Morton lacks explicit recitation of the elements and limitations of claims 2-28, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 2-28 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 2-28, because such inclusion would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

Independent claim 29 is rejected for the same reasons as independent claim 1.

As per claims 30-40, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 29 and subsequent base claims depending from claim 29.

Morton lacks explicit recitation of the elements and limitations of claims 30-40, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 30-40 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 30-40, because such inclusion would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

Independent claim 41 is rejected for substantially the same reasons as independent claim 1.

As per claims 42-68, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 41 and subsequent base claims depending from claim 41.

Morton lacks explicit recitation of the elements and limitations of claims 42-68, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 42-68 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 42-68, because such inclusion would have provided a “viral

marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

NEW CLAIM REJECTIONS

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 1-68 are rejected under 35 U.S.C. §103(a) as being unpatentable over Morton 6,327,572; class 705/10 (12/04/2001) [US f/d: 12/06/1999] (herein referred to as "Morton").

As per claims 69-70, 75 & 78 Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 1 and subsequent base claims depending from claim 1.

Morton lacks explicit recitation of the elements and limitations of claims 69-70, 75 & 78, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 69-70, 75 & 78 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 69-70, 75 & 78, because such inclusion would have

provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

As per claims 71-72, 76 & 79 Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 29 and subsequent base claims depending from claim 29.

Morton lacks explicit recitation of the elements and limitations of claims 71-72, 76 & 79, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 71-72, 76 & 79 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 71-72, 76 & 79, because such inclusion would have provided a “viral marketing system in connection with an information service. . . .” (See Morton (col. 10, ll. 12-20)).

As per claims 73-74, 77 & 80, Morton (col. 6, ll. 10-67; FIG. 4; col. 2, ll. 7-67; col. 3, ll. 38-67; col. 8, ll. 30-67; FIG. 2; and whole document) shows the method of claim 41 and subsequent base claims depending from claim 41.

Morton lacks explicit recitation of the elements and limitations of claims 73-74, 77 & 80, even though Morton suggests same.

Official Notice is taken that both the concepts and the advantages of the elements and limitations of claims 73-74, 77 & 80 were well known and expected in the art at the time of the invention. It would have been obvious to a person of ordinary skill in the art at the time of the invention to include the elements and limitations of claims 73-74, 77 & 80, because such inclusion would have provided a "viral marketing system in connection with an information service. . . ." (See Morton (col. 10, ll. 12-20)).

RESPONSE TO ARGUMENTS

5. Applicant's arguments (Amendment A, paper#9, filed 12/15/2003) have been fully considered; however, said arguments are not persuasive for the following reasons:

NOTE: As per claims 2-28, 30-40, & 42-68, the Official Notice evidence presented in the prior Office action is deemed admitted evidence.

It is well settled in the law that "If Applicant does not seasonably traverse the well known statement during examination, then the object of the well known statement is taken to be admitted prior art. *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943). A seasonable challenge constitutes a demand for evidence made as soon as practicable during prosecution. Thus, Applicant is charged with rebutting the well known statement in the next reply after the Office action in which the well known statement was made." (See MPEP 2144.03).

In this case, Applicant's response lacks a demand for evidence of the Official Notice presented in prior Office Action; therefore, the Official Notice evidence presented is deemed admitted, and no further references are required in support of said Official Notice evidence.

Applicant's arguments (Amendment A, paper#9, pp. 21-28) assert that the claims of the instant invention are patentably distinct from the prior art of record but Applicant's arguments fail to recognize that obviousness can be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant's arguments concerning claims 1, 29, & 41 amount to a general allegation of patentability because Applicant's arguments fail to address the knowledge generally available to one of ordinary skill in the art at the time of the invention as pronounced in the prior Office action. In the obviousness rejections of the instant invention, the Examiner not only relies on modifying the teachings of the prior art to produce the claimed invention where there is some suggestion to modify, the prior Office action also relies on the knowledge generally available to one of ordinary skill in the art at the time of the invention to modify the prior art to produce the invention. Therefore, claims 1, 29, & 41 stand rejected

pursuant to 35 USC 103(a). Therefore, claims 1-80 are rejected for the reasons stated above.

CONCLUSION

6. Any response to this action should be mailed to:

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Any response to this action may be sent via facsimile to either:

(703) 746-7239 or (703) 872-9314 (for formal communications EXPEDITED
PROCEDURE) or (703) 746-7239 (for formal communications marked AFTER-FINAL) or
(703) 746-7240 (for informal communications marked PROPOSED or DRAFT).

Hand delivered responses may be brought to:

Seventh floor Receptionist
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2451 Crystal Drive
Arlington, Virginia.

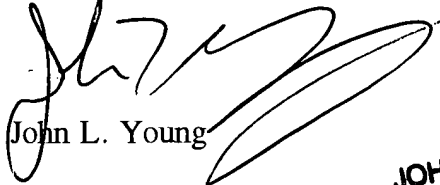
Any inquiry concerning this communication or earlier communications from the examiner should be directed to John L. Young who may be reached via telephone at (703) 305-3801. The examiner can normally be reached Monday through Friday between 8:30 A.M. and 5:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, may be reached at (703) 305-8469.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



John L. Young
Patent Examiner

**JOHN LEONARD YOUNG, ESQ.
PRIMARY EXAMINER**

March 7, 2004